APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/614,969	07/08/2003	Dennis P. Schwartz	SCHW P001USC1	8787

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EXAMINER
DASS, HARISH T

ART UNIT	PAPER NUMBER
3692	

MAIL DATE	DELIVERY MODE
06/30/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	10/614,969	SCHWARTZ ET AL.
	Examiner	Art Unit
	Harish T. Dass	3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 March 2008*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

     1.☐ Certified copies of the priority documents have been received.

     2.☐ Certified copies of the priority documents have been received in Application No. _____.

     3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

Detail Rejection

1.   *This action is in response to Applicant's communication of 3-26-2008.*

2.   ***Status of claims:***

Claims 1-27 are pending.

Claims 1, 5, 9, 12, and 20 are amended.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The rejected claims cover every conceivable product. Particularly, "auditing system" is not in original specification and claims.

4.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention.

Claim 20 recites the limitation "said auditing system" in2. There is insufficient

antecedent basis for this limitation in the claim.

Claim Objections

5.   Claim 02 is objected to under 37 CFR 1.75(c), as being of improper dependent

form for failing to further limit the subject matter of a previous claim. Applicant is

required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper

dependent form, or rewrite the claim(s) in independent form. Claim 20 is system claim

which dependent of a method claim with different statutory class..

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

Claims 17-27 remained rejected under 35 U.S.C. 103(a) as being unpatentable over

Broadbent et al. (hereinafter Broadbent – US 2001/0047326) in view of Florance et al.

(hereinafter Florance – US 7,076,452).

Re. Claim 17, Broadbent discloses computer implemented method, and system for preparing loan documents:

storing data and procedures for processing said data provided by a mortgage originator in a first database; storing data and procedures for processing said data provided by an investor in at least one additional database; comparing data provided by said mortgage originator to data provided by said investor [read entire document particularly at minimum, paragraphs 11, 19];

identifying discrepancies between said data provided by said mortgage originator and said investor [para. 275]; supplying additional information to prepare the documents to a documentation preparation engine [para. 20]; a compliance engine that determines if (examiner note: conditional language, not positively claimed) said reconciled data and said additional information are consistent with said procedures for processing said data provided by said mortgage originator and said investor, and wherein noncompliant reconciled data or additional information is reconciled and delivering said populated documents for execution [para. 51, 64-68, 127].

Broadbent does not explicitly disclose reconciling said discrepancies; auditing said reconciled discrepancies and populating data and additional information consistent with procedures for processing said data provided by said mortgage originator and said investor into documents contained within a forms library. However, Florance discloses reconciling said discrepancies; auditing (examining) said reconciled discrepancies and populating data and additional information consistent with procedures for processing said data provided by said mortgage originator and said investor into documents

contained within a forms library [see entire document, at minimum see, col. 20 lines 49-65, col. 29 lines 52-60, col. 59 lines 45-61]. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Broadbent and include reconciling said discrepancies; auditing (examining and underwriting) said reconciled discrepancies and populating data and additional information consistent with procedures for processing said data provided by said mortgage originator and said investor into documents contained within a forms library, as disclosed by Florance, to correlate data, and databases for facilitating for real estate loan applications and manipulating the data for examination for processing a loan application and underwriting.

Re. Claims, 18-27, Broadbent discloses wherein said mortgage originator enters data into said first database via a software package [para. 11, 25], wherein said procedures for processing said data provided by said mortgage broker and said investor comprise business rules and or compliance requirements [para. 51], wherein said comparison engine writes said reconciled data to said first database or said at least one additional database [inherently record can be added, deleted to database], wherein said at least one additional database comprises at least one database selected from the group consisting of property tax databases, independent property valuations databases, income/employment verification databases, income tax databases, and credit databases [para. 24], wherein said business rules comprise investor business rules, regulatory compliance requirements, or insurability requirements [para. 24], compliance

requirements are issued by at least one entity selected from the group consisting of

federal government agencies, state governments, local governments, banking

regulators, FHA, VA, and FNMA/FHLMC [para. 13, 25], re-auditing (recheck) and

allowing said broker to select additional documents from said forms library [Figure 4D

and associated description].

Florance further discloses manipulating individual data fields within said

populated documents, documents are populated automatically, re-auditing the

documents with said compliance engine and reconciling discrepancies created by

manipulating individual data fields within said populated documents, reconciling

discrepancies created by adding additional documents and creating create database

sets [see above]. It would have been obvious at the time the invention was made to a

person having ordinary skill in the art to modify the disclosure of Broadbent and include

reconciling said discrepancies; auditing (examining and underwriting) said reconciled

discrepancies and populating data and additional information consistent with

procedures for processing said data provided by said mortgage originator and said

investor into documents contained within a forms library, as disclosed by Florance, to

correlate data, and databases for facilitating for real estate loan applications and

manipulating the data for examination for processing a loan application and

underwriting.

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Broadbent

et al. (hereinafter Broadbent – US 2001/0047326) in view of Florance et al. (hereinafter

Florance – US 7,076,452) and Acosta et al. (hereinafter Acosta - US 6,643,625).

Re. Claims, 1, and 9, Broadbent discloses computer implemented method, and

system for preparing loan documents:

storing data and procedures for processing said data provided by a mortgage

originator in a first database; storing data and procedures for processing said data

provided by an investor in at least one additional database; comparing data provided by

said mortgage originator to data provided by said investor [read entire document

particularly at minimum, paragraphs 11, 19];

identifying discrepancies between said data provided by said mortgage originator

and said investor [para. 275]; supplying additional information to prepare the documents

to a documentation preparation engine [para. 20]; a compliance engine that determines

if (examiner note: conditional language, not positively claimed) said reconciled data and

said additional information are consistent with said procedures for processing said data

provided by said mortgage originator and said investor, and wherein noncompliant

reconciled data or additional information is reconciled and delivering said populated

documents for execution [para. 51, 64-68, 127].

Broadbent does not explicitly disclose reconciling said discrepancies; auditing

said reconciled discrepancies and populating data and additional information consistent

with procedures for processing said data provided by said mortgage originator and said

investor into documents contained within a forms library, and auditing system. However,

Florance discloses reconciling said discrepancies; auditing (examining) said reconciled

discrepancies and populating data and additional information consistent with

procedures for processing said data provided by said mortgage originator and said

investor into documents contained within a forms library [see entire document, at

minimum see, col. 20 lines 49-65, col. 29 lines 52-60, col. 59 lines 45-61]. It would have

been obvious at the time the invention was made to a person having ordinary skill in the

art to modify the disclosure of Broadbent and include reconciling said discrepancies;

auditing (examining and underwriting) said reconciled discrepancies and populating

data and additional information consistent with procedures for processing said data

provided by said mortgage originator and said investor into documents contained within

a forms library, as disclosed by Florance, to correlate data, and databases for facilitating

for real estate loan applications and manipulating the data for examination for

processing a loan application and underwriting.

Acosta discloses auditing system [Abstract; Figure 1; Col. 1 lines 1+ "System and

Method for Auditing", "ACES audit system"]. It would have been obvious at the time the

invention was made to a person having ordinary skill in the art to modify the disclosure

of Broadbent and Florance and include auditing system, as disclosed by Acosta, to

provide a computerized loan auditing system for automating the auditing, storing loan

records, legal regulation, investor specific parameters to facilitate a customized auditing

criteria for storing, reporting on audit recommendations and exceptions.

Re. Claims, 2-8 and 10-16, Broadbent discloses wherein said mortgage originator

enters data into said first database via a software package [para. 11, 25], wherein said

procedures for processing said data provided by said mortgage broker and said investor

comprise business rules and or compliance requirements [para. 51], wherein said

comparison engine writes said reconciled data to said first database or said at least one

additional database [inherently record can be added, deleted to database], wherein said

at least one additional database comprises at least one database selected from the

group consisting of property tax databases, independent property valuations databases,

income/employment verification databases, income tax databases, and credit

databases [para. 24], wherein said business rules comprise investor business rules,

regulatory compliance requirements, or insurability requirements [para. 24], compliance

requirements are issued by at least one entity selected from the group consisting of

federal government agencies, state governments, local governments, banking

regulators, FHA, VA, and FNMA/FHLMC [para. 13, 25], re-auditing (recheck) and

allowing said broker to select additional documents from said forms library [Figure 4D

and associated description].

Florance further discloses manipulating individual data fields within said

populated documents, documents are populated automatically, re-auditing the

documents with said compliance engine and reconciling discrepancies created by

manipulating individual data fields within said populated documents, reconciling

discrepancies created by adding additional documents and creating create database

sets [see above]. It would have been obvious at the time the invention was made to a

person having ordinary skill in the art to modify the disclosure of Broadbent and include

reconciling said discrepancies; auditing (examining and underwriting) said reconciled

discrepancies and populating data and additional information consistent with

procedures for processing said data provided by said mortgage originator and said

investor into documents contained within a forms library, as disclosed by Florance, to

correlate data, and databases for facilitating for real estate loan applications and

manipulating the data for examination for processing a loan application and

underwriting.

Acosta discloses auditing system [Abstract; Figure 1; Col. 1 lines 1+ "System and

Method for Auditing", "ACES audit system"]. It would have been obvious at the time the

invention was made to a person having ordinary skill in the art to modify the disclosure

of Broadbent and Florance and include auditing system, as disclosed by Acosta, to

provide a computerized loan auditing system for automating the auditing, storing loan

records, legal regulation, investor specific parameters to facilitate a customized auditing

criteria for storing, reporting on audit recommendations and exceptions.

Response to Arguments

7.   Applicant's arguments filed 3-26-2008 have been fully considered but they are

not persuasive.

In response to Applicant's argument, the recitation "Broadbent does not disclose

a computer implemented method for preparing loan documents." has not been given

patentable weight because the recitation occurs in the preamble. A preamble is

generally not accorded any patentable weight where it merely recites the purpose of a

process or the intended use of a structure, and where the body of the claim does not

depend on the preamble for completeness but, instead, the process steps or structural

limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA

1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

However, Broadbent inherently discloses method for preparing loan documents,

see the entire document which is directed to loan processing. Broadbent discloses the

concept of accepting loan application and processing the application (see at least:

Figure 3 (#300 "documentation processing"; paragraphs 54 "The system contains the

Compliance Engine that applies Federal, State, Local, and profession based filters to

each loan application", 66, 100). Broadbent's paragraphs 54 states "The system

contains the Compliance Engine that applies Federal, State, Local, and profession

based filters to each loan application", which means that there is compliance engine

which check/audits the loan application with Federal, State, and local laws, etc, and

managing the mortgage process and tracking the mortgage process through "originate",

"approve", "close", "fund", "title", "appraisal" (see at least abstract) and "produces a

Compliance Report and loan specific Closing Instruction" (paragraph 68). It is obvious

these are loan preparing documentation. See figures 31-32, which show the detail of

computer implemented system that processes the mortgage loan. With broadest

reasonable interpretation of "computer implemented method for (intended use)

preparing loan document" These show that Broadbent discloses the unclaimed

limitation.

In response to Applicant's argument that "Specifically neither Paragraph [0011] nor

[009] disclose storing data and procedures for processing data by mortgage originator in

a first database storing data and procedures for processing said data provided … is

performed." MPEP requires the Applicant to consider the entire document. Examiner

has pointed out particular references contained in the prior arts of record in the body of

this action for the convenience of the applicant. Although the specified citations are

representative of the teachings in the art and are applied to the specific limitations within

the individual claim, other passages and figures may apply as well, and even Examiner

has stated on page of office action "[read entire document …]. Please read the entire

document and paragraph 119.

In response to Applicant's argument that "Rather, Paragraph [0011] merely teaches that

automated loan application processing systems make loan application process more

efficient and centrally controlled. …"

In response to applicant's argument that "Paragraph [0275] at no point teaches the

identification of discrepancies between the mortgage originator and investor."

    With broadest reasonable of interpretation of the claimed limitation, it is obvious

that Paragraph [0275] discloses this limitation. See "submit a task completion message

to the system 631 and *it compares the submissions* (loan application by investor or

buyer) against authorization criteria (mortgage originator). If the criteria are met the

system determines whether the user has requested that the loan rate be locked 635 and

if so the loan is locked-in with the investor 661 and a message is passed to the clear-to-

close auditor 665,659 where a determination is made as to whether the transaction is

clear-to-close 667. If so a message is passed to the closer 669 to close the loan 677."

Compares means it checks the difference between the two.

In response to applicant's argument that "Florance does not relate to the preparation of

mortgage documents as well." is nonanalogous art, it has been held that a prior art

reference must either be in the field of applicant's endeavor or, if not, then be

reasonably pertinent to the particular problem with which the applicant was concerned,

in order to be relied upon as a basis for rejection of the claimed invention. See *In re*

Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Florance is an

analogous art, see Florance mortgage loan (see col. 7 lines 34+) and underwriting the

loan (col. 8 3+).

In response to applicant's argument that "a Prima Facie Case of Obviousness …" there

is no suggestion to combine the references, the examiner recognizes that obviousness

can only be established by combining or modifying the teachings of the prior art to

produce the claimed invention where there is some teaching, suggestion, or motivation

to do so found either in the references themselves or in the knowledge generally

available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5

USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed.

Cir. 1992), also see KSR (combining know elements and obviousness paragraphs), In

re Oetiker, and In re Hedges. In this case (correlate data, and databases for facilitating

for real estate loan applications and manipulating the data for examination for

processing a loan application and underwriting).

Conclusion

8.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Harish T. Dass whose telephone number is 571-272-

6793. The examiner can normally be reached on 8:00 AM to 4:50 PM.

   If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Abdi Kambiz can be reached on 571-272-6702. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

   Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

                                        /Harish T Dass/
                                        Primary Examiner, Art Unit 3692

6/22/2008